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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,790	09/27/2005	Yuichi Marikawa	5341-57PUS	1803
27799 7590 04/01/2010 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
HAQ, NAEEM U				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
04/01/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,790

Applicant(s)

MARIKAWA ET AL.

Examiner

NAEEM HAQ

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, and 11 is/are rejected.
- 7) ☒ Claim(s) 4-6, 8-10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/27/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 9/27/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

Claims 4-6, 8-10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. (US 2002/0067500 A1) ("Yokomizo") in view of Ida et al. (US 7,050,070 B2) ("Ida").

Referring to claims 1, 7, and 11: Yokomizo teaches an image-editing service system comprising: a network (paragraph [0002]); a server connecting to the network (paragraph [0034]); a user terminal for performing a design order connecting to the network (paragraph [0043]); an administrator terminal connecting to the network for receiving the design order via the server and performing an order of image-editing work based on the design order (paragraph [0212]); a worker terminal connecting to the network for performing image-editing based on the order of image-editing work and for creating an image information (paragraphs [0169] and [0170]); and, the server comprising; a database for storing the image information sent from worker terminal (paragraph [0168]); a first image generating section for generating a first image based on the image information stored in the database (paragraph [0197]); a display section for displaying an image display frame so as to display the first image in a display window of the user terminal and displaying a window information so as to display a display condition of the first image which is allowed to be input (Figure 7, "70"). Yokomizo does not teach a second image generating section for generating a second image regard to the first image based on the display condition inputted by the user

terminal; and, a window information generating section for displaying the first image and the second image simultaneously. However, Ida teaches a method and apparatus that generates a second image regard to the first image based on the display condition inputted by the user terminal; and, a window information generating section for displaying the first image and the second image simultaneously (Figures 4 and 5). It would have been obvious to one of ordinary skill in the art to include in the invention of Yokomizo the composite imaging ability of Ida since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. (US 2002/0067500 A1) ("Yokomizo") in view of Ida et al. (US 7,050,070 B2) ("Ida") and further in view of Hama et al. (US 4,751,507) ("Hama").

The cited prior art does not teach a display section for displaying the first image can select either a whole display or a partial display on the display window of the user terminal; wherein the window information generating section for displaying the first image and the second image simultaneously when the whole display is selected by the user terminal, while displaying a portion of the first image when the partial display is selected by the user terminal. However, Hama teaches a partial display of an image (Figure 5, "23" and "25"). It would have been obvious to one of ordinary skill in the art to include in the invention of Yokomizo the partial display ability if Hama since the claimed invention is merely a combination of old elements, and in the combination

each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAEEM HAQ whose telephone number is (571)272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/

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Primary Examiner, Art Unit 3625

March 23, 2010